

Remarks:

Reconsideration of the application is requested.

Claims 1-18 remain in the application. Claims 1-3, 9-10, and 15 have been amended.

In item 2 on page 2 of the above-identified Office action, claims 1-3, 10, and 15 have been rejected as being indefinite under 35 U.S.C. § 112, first paragraph.

In item 4 on page 2 of the Office action, claims 1-18 have been rejected as being indefinite under 35 U.S.C. § 112, second paragraph.

More specifically, the Examiner has stated that the term "activatable material" is not (sufficiently) defined in the specification and that "[t]he specification does not teach what this material is."

The instant application states on page 6, lines 9-14, that:

... a reaction of the **activatable material** is deliberately **initiated** ... and the cavity originally deliberately
~~formed between the activatable material and the outer~~
plate is filled by the **foam** which forms.

Similarly on page 7, line 23, through page 8, lines 18:

... solid core material 1 coated with an activatable material 2. An outer plate 4 is disposed to form a cavity 3. The cavity 3 is completely filled by the operation of *foaming* the *activatable material* 2. ...

Before the *foaming* operation, the hollow section 6 is passed to a corrosion protection dipping bath. ... [The] higher temperature in the drying oven results in a *reaction* of the *coating material*, as a result of which the *foaming operation is initiated* and the cavity 3 which has been deliberately formed is filled with *foam*.

Consequently, it is believed to be clear that the activatable material disclosed in the specification refers to material which is activatable to foam, and if activated, form foam. In other words, the activatable material disclosed in the specification is activatable *foamable* material.

In view of the Examiner's § 112 rejections, the claims have been amended by replacing the phrase "activatable material" with "activatable foamable material". For the reasons stated in the preceding paragraph, this amendment does not introduce new matter to the instant application. No amendment to the specification is believed to be necessary for the same reason.

It is accordingly believed that the claims meet the requirements of 35 U.S.C. § 112, first and second paragraphs. Should the Examiner find any further objectionable items,

Counsel would appreciate a telephone call during which the matter may be resolved. The above-noted changes to the claims are provided solely for the purpose of satisfying the requirements of 35 U.S.C. § 112. The changes are neither provided for overcoming the prior art nor do they narrow the scope of the claims for any reason related to the statutory requirements for a patent.

In item 8 on page 4 of the Office action, claims 1-14 have been rejected as being obvious over *Thum in view of Soderberg* (US 5,160,465) under 35 U.S.C. § 103.

As will be explained below, it is believed that claims 1-14 were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 as amended calls for, inter alia:

coating a solid core material with activatable foamable material;

enclosing the solid core material and the activatable foamable material with an outer plate to form an assembly with a defined cavity inside said outer plate;

passing the assembly to a corrosion treatment bath and subjecting all interior areas of the assembly to a corrosion protection agent; and

subsequently passing the assembly to a drying oven for heating and, thereby, initiating foaming of the activatable foamable material at least partly filling the defined cavity.

In item 9 on page 4 in the Office action, the Examiner stated that "Thum fails to teach the processing steps whereby corrosion treatment is separate and prior to the expansion of foam step." The Examiner then applies the secondary reference *Soderberg* for teaching "a process of insulating a body cavity comprising the assembly, corrosion treatment-separate and prior to expansion of the foam (col. 2, lines 66 - col. 3, lines 14) [sic]".

The cited passages of *Soderberg* state:

... assembling the part in the open space of a vehicle body ... submitting the **vehicle to ... anti-corrosion treatment** whilst the insert remains unexpanded; and

submitting the vehicle body to ... curing treatment ... such that the insert expands, contacts and adheres to the surrounding **metal** surface

(emphasis added)

**Soderberg Does Not Disclose Or Teach The Step For Which
It Was Applied By The Examiner**

Soderberg discloses submitting the (whole) vehicle to anti-corrosion treatment, but does not disclose submitting the interior areas to corrosion treatment. Hence, Soderberg does not disclose the step of "subjecting all *interior* areas of the *assembly* to a corrosion protection agent" as recited in the claims. Soderberg states that the expanded compound contacts the surrounding *metal* surface and not, like the invention of the present invention, an (previously) applied corrosion protection agent.

In col. 3, lines 14-15, Soderberg states that "[t]he foam is non-moisture-absorbing and so corrosion of vehicle parts can be minimised". If the interior areas of the assembly in Soderberg would be subject to anti-corrosion treatment, then it would not be necessary to use a non-moisture-absorbing foam to minimize corrosion. Hence in fact, Soderberg teaches away from subjecting the interior areas of the assembly to anti-corrosion treatment. (The disclosure of Soderberg is very similar to Russell and therefore the same considerations regarding Russell, discussed in great detail in the last response, also apply to Soderberg).

Arguments Against Combining Thum And Soderberg

Soderberg discloses a composition foamed to provide closed cell foam "so as to provide a sound and/or moisture barrier" (col. 1, lines 10-11). In contrast, *Thum* discloses a "beam-like structural part" "that will absorb kinetic energy upon impact" (col. 1, lines 12-13). MPEP § 2143 requires that there "must be some suggestion or motivation with a reasonable expectation of success". Considering the different purposes and structural considerations of *Thum* and *Soderberg*, it is doubtful that this requirement for combining *Thum* and *Soderberg* is satisfied.

In item 6 on page 3 of the Office action, claims 15-18 have been rejected as being anticipated by *Thum* (US 5,194,199) under 35 U.S.C. § 102.

The rejection of claims 15-18 has been noted and claim 15 have been amended to recite "a corrosion protection agent applied to all interior areas of said assembly before heating said assembly". As discussed in great detail in previous responses, *Thum* does not disclose or suggest subjecting the interior areas of an assembly to a corrosion protection agent.

**Objective Evidence Or Secondary Considerations Suggesting
Non-Obviousness**

MPEP §2141 (8th ed, 2001) states:

OBJECTIVE EVIDENCE MUST BE CONSIDERED

Objective evidence or secondary considerations such as unexpected results, commercial success, longfelt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. When evidence of any of these secondary considerations is submitted, the examiner must evaluate the evidence. The weight to be accorded to the evidence depends on the individual factual circumstances of each case.

Hence, according to MPEP §2141, objective evidence or secondary considerations relevant to the issue of non-obviousness must be considered in every case in which they are present. Applicant submits a copy of the European Patent *Beckmann* (EP 1 064 188 B1) which was granted on a patent application which corresponds to the instant application, as objective evidence or secondary considerations relevant to the issue of non-obviousness. The cited and applied references in *Beckmann* (EP 1 064 188 B1) are *Thum* and *Russell*.

It is accordingly believed to be clear that *Thum* in view of *Soderberg* do not suggest the features of claim 1 and that *Thum* does not show the features of claim 15. Claims 1 and 15 are,

therefore, believed to be patentable over the art and since

claims 2-14 and 16-18 are ultimately dependent on claims 1 and 15, respectively, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-18 are solicited.

Please charge any fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,

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Version with markings to show changes made:

Claim 1 (thrice amended). A method of producing a hollow section with internal reinforcement, which comprises:

coating a solid core material with activatable foamable material;

enclosing the solid core material and the activatable foamable material with an outer plate to form an assembly with a defined cavity inside said outer plate;

passing the assembly to a corrosion treatment bath and subjecting all interior areas of the assembly to a corrosion protection agent; and

subsequently passing the assembly to a drying oven for heating and, thereby, initiating foaming of the activatable foamable material at least partly filling the defined cavity.

Claim 2 (amended). The method according to claim 1, wherein the cavity is defined between the outer plate and the activatable foamable material.

Claim 3 (amended). The method according to claim 1, wherein the cavity is completely filled by foaming the activatable foamable material

Claim 9 (amended). The method according to claim 1, which comprises forming the cavity between the activatable foamable material and the outer plate with spacers formed on the activatable foamable material.

Claim 10 (amended). The method according to claim 1, wherein the coating step comprises coating the solid core material with the activatable foamable material only in some areas.

Claim 15 (thrice amended). A hollow section, comprising:

a solid core material formed of a material selected from the group consisting of foamed metallic material, unfoamed metallic material, synthetic material reinforced with fibers selected from the group consisting of metal fibers, carbon fibers, and glass fibers;

an activatable foamable material enclosing said solid core material;

an outer plate enclosing said solid core material and said activatable foamable material to form an assembly with a defined cavity inside said outer plate; and

a corrosion protection agent applied to all interior areas of
said assembly before heating said assembly and, thereby,
initiating foaming of the activatable foamable material at
least partly filling said defined cavity.